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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,584	04/16/2001	Eugeniusz Rylewski	154.1049	3718

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EXAMINER	
CIRIC, LJILJANA V	
ART UNIT	**PAPER NUMBER**
3753	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

5/2

Office Action Summary	Application No.	Applicant(s)	
	09/786,584	RYLEWSKI, EUGENIUSZ	
	Examiner	Art Unit	
	Ljiljana (Lil) V. Ciric LVC	3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-17 and 23-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-17 and 23-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 10, 2005 has been entered.

2. Claims 12 through 17 and 23 through 28 remain in the application, as amended.

Response to Arguments

3. Applicant's arguments filed on March 10, 2005 have been fully considered but they are not persuasive.

For example, applicant's reliance on the passage on page 9, lines 24-26 of the specification to prove that it is possible to have no exchange of heat or no recuperation of heat is not understood, since the aforementioned passage states that there is a resultant "*low* amount of heat exchange", and "low" is not synonymous with "no".

With regard to applicant's arguments relating to the rejection based on the Oberschmid reference, applicant is respectfully reminded that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Also, "[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

In response to applicant's argument that the Oberschmid reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Oberschmid reference is drawn to a heat exchanger including circulation means used in building ventilation and cooling, just like the instant invention.

In response to applicant's argument that the *Oberschmid* reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., no strings or ropes being required to create air channels or to adjust the geometry of the fluid passages of the instant invention) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 12 through 17 and 28 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims contain subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Amended base claim 12 and claim 28 each recites that "there is an exchange of air without recuperation of heat". Even though the originally filed disclosure does state that "if only one of the two [fans] is running there is an exchange of air without recuperation of heat [from the warmer air stream by the cooler air stream]", the originally filed disclosure, taken as a whole, fails to explain how the instant invention is able to operate in apparent contradiction to accepted heat transfer principles which dictate that convective heat transfer will *inherently* occur in response to the flow of a heat transfer fluid past a heat transfer surface *at least whenever there is any temperature difference between the fluid and the surface.* Thus, absent any description or disclosure as to how the inventive heat exchange unit is to be specifically configured and operated without heat exchange or without recuperation of heat when one of the two extraction fans is running and the other of the two extraction fans is stopped, one of ordinary skill in the art would not know how to make or use the inventive heat exchange unit so as to effect the specific operating conditions as recited.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12 through 17 and 23 through 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations "and there is an exchange of air without recuperation of heat, one of the two extraction fans is running and the other of the two extraction fans is stopped" in the last two lines of each of base claim 12 and of claim 28 appear to have a word or words missing therefrom, and are thus rendered generally incomprehensible thereby.

Furthermore, each of amended base claim 12 and claim 28 recites that "there is an exchange of air without recuperation of heat". However, accepted heat transfer principles dictate that convective heat

transfer will *inherently* occur in response to the flow of a heat transfer fluid past a heat transfer surface *at least whenever there is any temperature difference between the fluid and the surface.* The seeming contradiction between art-accepted scientific principles and the limitations appearing in the claims of the instant application, coupled with the lack of a clear disclosure as to how the inventive heat exchange unit is to be specifically configured and operated so as to *preclude* heat exchange or heat recuperation when one of the two extraction fans is running and the other of the two extraction fans is stopped, renders indefinite the scope of protection sought by claims 12 through 17 and claim 28.

With regard to base claim 23 as amended, it is not clear whether the limitation "a building" as recited in line 5 of claim 23 refers back to the same building as that referred to in the preamble of the claim. If so, recommend replacing each occurrence of "a building" with "the building", for example, as appropriate.

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 12 through 17 and 28 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. For example, each of amended base claim 12 and new claim 28 recites that "there is an exchange of air without recuperation of heat". However, even one running extraction fan generates a flow of air through one of the fluid passages, and at least some convective heat transfer is inherent and unavoidable if any of the surfaces past which the air flow generated by the one extraction fan is at a temperature that is different than the generated air flow. Thus, there can be no

blanket recitation of there being no of heat exchange or no recuperation of heat and the invention is thus inoperative as claimed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. As best can be understood in view of the indefiniteness of the claims, 12 through 17 and 23 through 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Oberschmid (DE 40 07 963 A1—previously of record).*

Oberschmid (DE 40 07 963 A1), especially Figure 3, discloses a heat exchange unit essentially as claimed, including: a box provided with walls 1 as shown in Figure 3 [which is associated with Figures 2a and 2b, as well as claim 13 of the reference] defining two fluid passages 3 and 4 having a cross section of undulating shape along the length of the heat exchanger box as shown in Figures 2a and 3, the walls bounding the fluid passages including a removable thin flexible foil 20 which is air-tight and impermeable to water vapor except at condensate removal perforations or openings 21, at which openings 21 the foil 20 is permeable to both water vapor and air; and, an air circulator including at least one entry fan 10 and at least one extraction fan 11. A fan controller is depicted in Figure 8. An operating air circulator or fan or pump or blower inherently produces air streams *under pressure*. Also, thin flexible foil is inherently capable of being deformed as a function of the air pressure variations due to forced air or other fluid flow therethrough. Turning an apparatus on its end, and thereby changing the relative orientation of the component elements of the apparatus--such as by rotating the apparatus from a horizontal orientation to a vertical orientation, does not change the structure of the apparatus and is thus immaterial to the patentability of the same.

Oberschmid however does not necessarily disclose either the location of the fans as being exactly as recited in amended base claim 12 of the instant application, for example, nor does it disclose there being two extraction fans 11 instead of one. Nevertheless, shifting the location of parts, absent unexpected results, as well as duplicating parts for a multiplied effect, are matters of design choice and are thus not inventive. See St. Regis Paper Co. V. Bemis Co., Inc., 193 USPQ 8, 11 (7th Cir. 1977) and In re Japikse, 86 USPQ 70 (CCPA 1950).

Thus, it would have been obvious to one skilled in the art at the time of invention to modify the heat exchange unit of *Oberschmid* by shifting the locations of the fans in order to effect particular desired flow patterns and/or conform with particular space requirements for a given application. It would likewise have been obvious to one skilled in the art at the time of invention to modify the heat exchange unit of *Oberschmid* by duplicating the number of extraction fans within the unit in order to, for example, either double the amount of airflow and/or heat exchange effected thereby or to reduce the size of any one fan.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (571) 272-4909.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene, can be reached at (571) 272-4930.

lvc

May 14, 2005

LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3753